

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

LEUNG *et al.*

Serial No.: 09/988,013

Filed: November 16, 2001

Title: IMMUNOCONJUGATES AND HUMANIZED
ANTIBODIES SPECIFIC FOR B-CELL
LYMPHOMA AND LEUKEMIA CELLS

Group Art Unit: 1643

Examiner: Meera NATARAJAN

Attorney Docket No.: IMMU-0014US2

Confirmation No.: 7681

VIA EFS-WEB

PETITION UNDER 37 CFR § 1.183

COMMISSIONER FOR PATENTS
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450

Sir:

This is a renewed petition to request that the requirement that a declaration under 37 CFR 1.131 be signed by all of the inventors in an application be waived for Patent Owner's Appeal Brief. The fee of \$400 for this petition under 37 CFR 1.17(f) is addressed in the EFS-Web generated transmittal, however, the Commissioner is authorized to charge any deficiency in the fee, or any other necessary fee, to Deposit Account 18-2056.

37 CFR 1.183 provides that:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed.

The present situation is extraordinary, and justice requires that the PTO accept the Declaration under 37 CFR 1.131 of Hans Hansen alone, without requiring a Declaration under 37 CFR 1.131 of Shui-On Leung. MPEP 715.04 explicitly provides that a petition under

37 CFR 1.183 is appropriate in a situation where a declaration under 37 CFR 1.131 of an inventor cannot be obtained.

MPEP 715.04 provides that the following parties may make an affidavit or declaration under 37 CFR 1.131:

(A) All the inventors of the subject matter claimed.

(B) An affidavit or declaration by less than all named inventors of an application is accepted where it is shown that less than all named inventors of an application invented the subject matter of the claim or claims under rejection. For example, one of two joint inventors is accepted where it is shown that one of the joint inventors is the sole inventor of the claim or claims under rejection.

(C) If a petition under 37 CFR 1.47 was granted or the application was accepted under 37 CFR 1.42 or 1.43, the affidavit or declaration may be signed by the 37 CFR 1.47 applicant or the legal representative, where appropriate.

(D) The assignee or other party in interest when it is not possible to produce the affidavit or declaration of the inventor. *Ex parte Foster*, 1903 C.D. 213, 105 O.G. 261 (Comm'r Pat. 1903).

MPEP 715.04 further provides that:

Where one or more of the named inventors of the subject matter of the rejected claim(s) (who had originally signed the oath or declaration for patent application under 37 CFR 1.63 is now unavailable to sign an affidavit or declaration under 37 CFR 1.131, the affidavit or declaration under 37 CFR 1.131 may be signed by the remaining joint inventors provided a petition under 37 CFR 1.183 requesting waiver of the signature of the unavailable inventor be submitted with the affidavit or declaration under 37 CFR 1.131. Proof that the non-signing inventor is unavailable or cannot be found similar to the proof required for a petition under 37 CFR 1.47 must be submitted with the petition under 37 CFR 1.183 (see MPEP § 409.03(d)). Petitions under 37 CFR 1.183 are decided by the Office of Petitions (see MPEP §1002.02(b)).

Applicant again petitions under 37 CFR 1.183 to proceed under MPEP 715.04(D), using only the declaration of Dr. Hans Hansen ("the other party in interest"). Applicant previously filed, on August 30, 2010, a petition under 37 CFR 1.183, requesting waiver of the requirement that

the declaration be signed by all inventors. A decision was mailed on December 13, 2010, dismissing applicants' petition.

The decision on applicant's petition stated the following:

Since petitioner is alleging that Leung is refusing to sign the declaration, at the very least, petitioner should mail correspondence to the non signing inventor's last known address, return receipt and/or forwarding address requested. If a forwarding address is provided, petitioner should then mail a complete copy of the declaration to Leung's address, return receipt requested, along with a cover letter of instructions which includes a deadline or a statement that no response will constitute a refusal. This sort of ultimatum lends support to a finding of refusal by conduct.

Following this, the undersigned attempted again to obtain Dr. Leung's signature, using the approach identified in the decision of December 13, 2010. These attempts were documented in a declaration of the undersigned which was filed in the USPTO on May 4, 2011, and a copy of which is appended. Namely, on March 15, 2011, the undersigned sent, via Federal Express International Priority Service, a final revised version of the declaration which included all of Dr. Leung's input as conveyed to the undersigned by Dr. Leung's attorney, Gregory Lantier. Applicant used the most recent address known to them for Dr. Leung, which was given by Dr. Leung in an affirmation filed on October 30, 2007, in Action No. 1767 of 2007, in the High Court of the Hong Kong Special Administrative Region. This affirmation was filed in connection with ongoing litigation with Immunomedics.

The declaration which was sent to Dr. Leung was accompanied by a cover letter which stated that "If you do not return the declaration within one month, *i.e.*, by April 14, 2011, we shall take that as a refusal on your part to execute the declaration in accordance with the terms of your employment agreement with Immunomedics, Inc." Also included was a prepaid envelope for return of the executed declaration.

On March 18, 2011, the undersigned was informed by Federal Express that Dr. Leung had moved, and was asked whether an undated address could be provided. The undersigned contacted Gregory Lantier, however he was unable to share a more current address for Dr. Leung. Subsequently, the Federal Express package was returned to the undersigned, with a notation that Dr. Leung had moved, dated March 18, 2011. A copy of the declaration and the cover letter, as well as the Federal Express label, and a copy of the stamped returned package were attached to the undersigned's declaration as Appendix A.

Upon learning that Dr. Leung had moved, the undersigned sent, on March 23, 2011, a second package, using the USPS International Guaranteed service, using a newly dated cover letter, and again providing a prepaid envelope for return of the enclosed declaration. The reason for this second attempt was to have a package that would route through the Hong Kong postal service, which might know of a forwarding address for Dr. Leung. The undersigned contacted the help line of the USPS International branch, and also had a staff member hand carry the package to the Post Office to ask whether the package would be forwarded by the Hong Kong postal service, to ascertain what would happen vis-à-vis forwarding in Hong Kong. The reply in both instances was that the forwarding of mail by a foreign postal service was not within their control, and there was no way of ascertaining whether the package would be forwarded. This second package also was returned to the undersigned, with the notation "addressee unknown." A copy of the cover letter, as well as the USPS Express Mail label, and a copy of the stamped returned package were attached to the undersigned's declaration as Appendix B.¹

The declaration of the undersigned was submitted to the examiner. However, the examiner has refused to accept this declaration, requiring that "A petition under 37 CFR 1.183 requesting waiver of the signature of the unavailable inventor be submitted *WITH* the affidavit or declaration under 37 CFR 1.131." Accordingly, the undersigned now files the present petition.

The undersigned now has provided an ultimatum which would support "a finding of refusal by conduct," as directed in the decision on petition mailed December 13, 2010. The undersigned has tried diligently to present the declarations to Dr. Leung for signature. Justice demands that the USPTO now accept the proffered evidence that a declaration executed by Dr. Leung cannot be obtained, and accept the declaration of Dr. Hansen with respect to the rejection based on Harris. Indeed, this was the response of the Senior Petitions Examiner in SN 11/676,466, when presented with a request that the requirement that a declaration under 37 CFR 1.131 be signed by all of the inventors in an application be waived.² SN 11/676,466 and the present case share priority to the same parent case. In that case, Applicant used the declaration of Bryan Wilson, which was submitted in this case in support of its petition to proceed without Dr. Leung's signature on his Rule 131 declaration. In SN 11/676,466,

¹ The declaration is not included in Appendix B, as it is the same as the one sent via Federal Express.

² Senior Petitions Attorney Shirene Willis Brantley decided the petition in SN 11/676,466, and Petitions Examiner Carl Friedman decided the petition in the present case.

applicant's petition was granted. The Senior Petitions Examiner who signed the decision on petition in that case found that:

Petitioner has established that the non-signing inventor, Shui-on Leung, has refused to sign the declaration. Therefore, in the interest of justice, the signature requirement of Dr. Leung on the declaration under 37 CFR 1.131 is waived.

It is submitted that applicant has done all within its power to obtain Dr. Leung's signature on his declaration, and have even taken the additional steps set forth by Petitions Examiner Carl Friedman in his decision on petition, which were not required by Senior Petitions Attorney Shirene Brantley.

Accordingly, it is believed that applicant has taken all necessary steps to obtain a declaration from Dr. Leung, and that since Dr. Leung has not provided such a declaration that the granting of this petition under 37 CFR 1.183 is proper. Further, it is submitted that proof that applicant attempted to obtain a signed Declaration under 37 CFR 1.131 of Dr. Leung is suitably documented in the record. Applicant should be allowed to proceed under MPEP 715.04(D) with just Dr. Hansen's declaration. As the co-inventor of this subject matter, Dr. Hansen qualified as "the other party in interest" which is specified in MPEP 715.04(D).

Respectfully submitted,

ROSSI, KIMMS & McDOWELL LLP

OCTOBER 19, 2011

DATE

/BARBARA A. McDOWELL/

BARBARA A. McDOWELL

REG. NO. 31,640

20609 GORDON PARK SQUARE, SUITE 150
ASHBURN, VA 20147
703-726-6020 (PHONE)
703-726-6024 (FAX)